

REMARKS

The Final Office Action that was mailed May 18, 2007, rejected pending claims 1-21 and requested that Figure 3 be labeled as "Prior Art." Applicant has amended claims 1, 3, 11, 14, 20, and 21 to more particularly define the subject matter sought to be patented, while canceling claims 2, 8-10, 13, 15-19. Applicant also added new claims 22-31. The amendments add no new matter. Claims 1, 3, 11, 14, and 20-31 remain pending. Applicant requests reconsideration in view of the amendments above and the following remarks.

Drawings

The Office Action objected to Figure 3 contending that the figure should be designated "Prior Art" by legend because only that which is old is illustrated. The Examiner contended that "Applicants appear to be arguing that Claim 21 is functionally equivalent to Fig. 3 . . . As such, [because] Claim 21 is [allegedly] not drawn to a novel invention . . . Figure 3 should . . . [be] designated by legend – Prior Art –." Applicant respectfully disagrees. Applicant did not argue that claim 21 and figure 3 are functionally equivalent; Applicant simply noted that figure 3 illustrates one embodiment of a novel prediction engine that, in one embodiment, is a "computer readable medium." (*See* specification at page 9, lines 24-25 and page 10, lines 1-2). The Applicant also noted that the novel prediction engine illustrated in figure 3 is, in some embodiments, capable of performing the novel method described in claim 21, thus figure 3 illustrates novel, non-obvious, and useful subject matter and does not show prior art. Pointing out that in some embodiments a novel prediction engine can perform a novel method is a far cry from stating that the novel prediction engine illustrated in figure 3 is equivalent to the novel computer readable-medium disclosed in claim 21.

Even if the Examiner correctly equated claim 21 with figure 3, which the Applicant does not concede, figure 3 is not prior art. The Examiner argues that since claim 21 is allegedly anticipated by the cited prior art, figure 3, which the Examiner considers equivalent to claim 21, must be labeled "Prior Art." Taken to its logical conclusion, the Examiner's rationale would require labeling as "Prior Art" any figure with subject matter arguably disclosed by a rejected claim. No statute, case law, or rule that the Applicant is aware of requires applicants to respond

to a prior art rejection in this manner. In addition, even if the Examiner is correct that claim 21 and figure 3 should be considered functionally equivalent (which the Applicant does not concede), the prior art still must disclose each and every limitation of the rejected claim. *See* MPEP 2131. The cited prior art does not disclose every limitation recited in amended claim 21. For example, claim 21 recites, *inter alia*, selecting one or more decision tree nodes by traversing a decision tree using the input value set, unless state information exists; if state information exists, using the state information to select one or more decision tree nodes by traversing the decision tree beginning from a decision tree node referenced by the state information; using the one or more selected decision tree nodes, the input value set, and the state information, if any exists, to generate a prediction result. The cited prior art does not disclose any of the aforementioned limitations. Thus, even if the Examiner is correct that a figure should be labeled "Prior Art" if an associated claim is rejected, amended claim 21 is not anticipated by the cited prior art. Thus, as figure 3 illustrates novel subject matter, the Applicant respectfully requests the Examiner withdraw the objection to the figure.

Claim Rejections – 35 U.S.C. § 112

The Office Action rejected claims 1-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action contended that "application system" is not sufficiently described in the specification so as to reasonably convey to one skilled in the art that the inventors, at the time of filing, had possession of the claimed invention. Applicant respectfully disagrees.

Applicant's specification as originally filed provides sufficient written description to comply with the written description requirement of 35 U.S.C. § 112. Applicant's specification describes "application system" in several locations. For example, at page 3, lines 11-14, an implementation is described where the "application system 102 includes various run-time applications, and that, in an implementation, "these applications are software applications running in a customer relationship management (CRM) environment, and may include customer interaction center or sales applications." The specification further describes an implementation where "the application system 102 may also include various engines and repositories used for collecting and storing information, such as customer or key performance indicator (KPI)

information.” (See specification at page 3, lines 14-16). Moreover, in an implementation, “[t]he application system 102 sends requests to the prediction engine 104 for executing prediction tasks,” that “may include one or more input values that are used during task execution.” (See specification at page 3, lines 16-18). In an implementation, “the application system 102 provides these values to the prediction engine 104 when they are available.” (See specification at page 3, lines 20-21). Specific examples are described at Applicant’s specification page 3, line 10 to page 4, line 7. Another example that includes a call-center agent using the application system is described from page 4, line 8 to page 5, line 13.

The Examiner contends that the term “application system” is not clearly defined because “The term is used . . . with indefinite meanings and vague ‘optional’ features. . . .” Specifically, the Examiner noted that the use of “may,” “such as,” and like terms in the Applicant’s specification rendered “application system” indefinite. The use of terms such as “may” in the specification do not justify a rejection under 35 U.S.C. 112, first paragraph. The use of these terms merely indicate that the disclosed embodiments of the invention serve as example implementations, and should not be construed as limitations on the claimed subject matter. The terms noted by the Examiner have been used in the present application in the same manner as in numerous issued patents. (See, e.g., U.S. Patents 6,836,773 and 6,983,348). If the Examiner would like to see additional examples of such issued patents, these can be provided. Thus, use of the term “may” and like terms does not create an enablement problem in the present application. As such, Applicant’s specification as originally filed has sufficient written description of an “application system,” and Applicant accordingly asks that the 35 U.S.C. § 112, first paragraph written description rejections of claims 1-21 be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Rejections based on Wikipedia’s “Computer hardware”

The Office Action issued a new rejection of claim 21 under 35 U.S.C. § 102(b) as being anticipated by Wikipedia’s “Computer hardware.” The Examiner contended that the Applicant argued that Claim 21 is functionally equivalent to Figure 3. (Office Action, pages 3 and 12). “As such, the Wikipedia references [*sic*] discloses all [the] elements of Fig. 3 and therefore each and every element of claim 21.” (Office Action, page 12). The Applicant respectfully disagrees.

While examiners must read claims in light of the specification, it is impermissible for examiners to read limitations from the specification into the claims. *See* MPEP 2145. Here, the Examiner has gone beyond reading limitations from outside sources into the claims; the Examiner has *replaced* claim 21 with figure 3 – clearly not in accord with accepted USPTO practice as described above. As noted earlier, the Applicant did not argue that claim 21 and figure 3 are functionally equivalent. The Applicant explained that the novel prediction engine shown in figure 3 could, in some embodiments, perform the novel method disclosed in claim 21. Thus, figure 3 illustrated novel, non-obvious, and useful subject matter, not prior art.

A rejection under 35 U.S.C. § 102 is proper when the alleged prior art reference teaches every element of the claim. *See* MPEP 2131. Amended claim 21 recites, *inter alia*, selecting one or more decision tree nodes by traversing a decision tree using the input value set, unless state information exists; if state information exists, using the state information to select one or more decision tree nodes by traversing the decision tree beginning from a decision tree node referenced by the state information; using the one or more selected decision tree nodes, the input value set, and the state information, if any exists, to generate a prediction result. The Wikipedia reference fails to disclose or suggest any of the aforementioned limitations; the reference simply describes generic computer hardware. Thus, the Wikipedia reference does not disclose each and every element of claim 21 and the rejection under 35 U.S.C. § 102(b) should be withdrawn.

Rejections based on Tinsley

The Office Action maintained the rejection of claims 1-11 and 13-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2003/0043815 to Tinsley et al. (“Tinsley”). Applicant submits that the amended claims define subject matter that is patentable over Tinsley.

Tinsley discloses using multiple stages of switches to route transactions between a source address and a destination address of a data communications system. (Paragraph 0023). Tinsley discloses that regional servers 55 process transactions with terminals or computers connected to a network and capture usage information for each user. (Paragraph 0025). A switch periodically takes snapshots of traffic and processor usage, and the information is archived. (Paragraph 0040). The latest information is correlated with previously archived data for usage patterns. (Paragraph 0040). Tinsley discloses a fabric that can be categorized in two high level groups: 1) audio and video programs; and 2) applications running on the fabric. (Paragraphs 0040-0042).

Tinsley does not disclose or suggest the elements of Applicant's amended claim 1. For example, Tinsley fails to disclose or suggest a computer-implemented method that includes selecting a first decision tree node by traversing one or more nodes of a decision tree using the first input value set; using the first decision tree node and the first input value set to compute a first prediction result; sending the first prediction result back to the application system; saving state information generated from the computation of the first prediction result; receiving a second input value set from the application system; or using the state information to select a second decision tree node by traversing the decision tree beginning at a decision tree node referenced by the state information.

Tinsley also does not disclose or suggest the elements of Applicant's new claims 21, 22, and 27. Specifically, Tinsley fails to disclose selecting one or more decision tree nodes by traversing a decision tree using the input value set, unless state information exists; if state information exists, using the state information to select one or more decision tree nodes by traversing the decision tree beginning from a decision tree node referenced by the state information; using the one or more selected decision tree nodes, the input value set, and state information, if any exists, to generate a prediction result; or saving state information generated from the computation of the prediction result; providing the prediction result to the application system.

Accordingly, claims 1, 21, 22, and 27 define subject matter that is patentable over Tinsley, as do dependent claims 3, 5-7, 11-12, 23-26 and 28-31. Thus, Applicant asks that the anticipation rejections of claims 1-11 and 13-21 based on Tinsley be withdrawn.

Rejections based on Tamayo

The Office Action also maintained the rejection of claims 1, 12-14 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0083067 to Tamayo et al. ("Tamayo"). Applicant submits that the amended claims define subject matter that is patentable over Tamayo.

Tamayo discloses an enterprise web mining system and method. (Title). Tamayo discloses collecting data from a plurality of data sources, integrating the data, generating data mining models, and generating recommendations. (Paragraph 0007).

Tamayo does not disclose or suggest the elements of Applicant's amended claim 1. For example, Tamayo fails to disclose or suggest a computer-implemented method that includes selecting a first decision tree node by traversing one or more nodes of a decision tree using the first input value set; using the first decision tree node and the first input value set to compute a first prediction result; sending the first prediction result back to the application system; saving state information generated from the computation of the first prediction result; receiving a second input value set from the application system; or using the state information to select a second decision tree node by traversing the decision tree beginning at a decision tree node referenced by the state information.

In addition, Tamayo does not disclose or suggest the elements of Applicant's amended claims 14 and 21 or Applicant's new claims 21, 22, and 27. Specifically, Tamayo fails to disclose selecting one or more decision tree nodes by traversing a decision tree using the input value set, unless state information exists; if state information exists, using the state information to select one or more decision tree nodes by traversing the decision tree beginning from a decision tree node referenced by the state information; using the one or more selected decision tree nodes, the input value set, and state information, if any exists, to generate a prediction result; or saving state information generated from the computation of the prediction result; providing the prediction result to the application system.

Accordingly, amended claims 1, 14, and 21 define subject matter that is patentable over Tamayo, as does rejected dependent claims 12. Thus, Applicant asks that the anticipation rejections of claims 1, 12, 14 and 21 based on Tamayo be withdrawn.

Claim Rejections – 35 U.S.C. § 101

The Office Action rejected claims 1-13 and 21 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Examiner contends that the claims are not directed statutory subject matter because the claims recite software steps that do not produce a useful, tangible, and concrete result. The Applicant respectfully disagrees. Amended claims 1 and 21 include an "application system." The term "application system" can include various engines and repositories for storing information. (See specification at page 3, lines 14-16). As noted in a prior response, a repository is a hardware element. The Examiner contends that because "application

system” was allegedly not defined with clarity, it should be given its ordinary meaning in the art, a program (Office Action, page 5). As noted above, “application system” has been defined with sufficient clarity, thus “application system” should be accorded its specification definition, which, in some embodiments, includes a repository, a hardware element. Accordingly, Applicant submits that claims 1 and 21 are directed to statutory subject matter, and asks that the non-statutory subject matter rejections for claims 1 and 21 be removed.

New claims 22-31

Applicants have added claims 22-31 to claim more completely the subject matter described in Applicants' specification. The added claims add no new matter. Support for the added claims appears in the specification as originally filed. The application now contains 20 claims, and of those, five are independent claims. As such, the application complies with 37 CFR 1.75(b)(1), effective November 1, 2007, that requires applicants to submit an examination support document if the application contains more than five independent claims or more than twenty-five total claims.

Applicants submit that claims 22-31 are in condition for allowance, and request that these claims be examined.

CONCLUSION

Applicant submits that claims 1, 3, 5-7, 11-12, 14, and 20-31 are in condition for allowance, and requests that the Examiner issue a notice of allowance.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

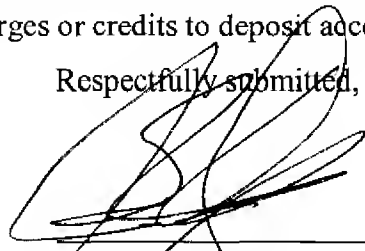
Applicant : Achim Kraiss
Serial No. : 10/757,651
Filed : January 14, 2004
Page : 15 of 15

Attorney's Docket No.: 13906-165001 / 2003P00822
US

Please charge \$810 for the Request for Continued Examination fee, \$460 for the Petition for Extension of Time fee and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 10/17/07



John A. Dragseth
Reg. No. 42,497

Fish & Richardson P.C.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696